

REMARKS/ARGUMENTS

The Office has required restriction in the present application between the following groups of claims:

Group I: Claims 1-26, drawn to a method for production of a nanoscale particle array.

Group II: Claims 27-39, drawn to a nanoscale particle array and magnetic information storage medium.

Applicants have elected, with traverse, Group II, claims 27-39 for further prosecution in this application.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has stated that Groups I and II are related as process of making and product made. Citing MPEP 806.05(f), the Office has stated that claims in this relationship can be shown to be patentably distinct if either or both of the following can be shown: (I) that the process as claimed can be used to make other and materially different product, or (II) that the product as claimed can be made by another and materially different process. The Office further states that the process of Group I of the present application can be used to make products other than those in Group II, such as a decorative article with gold deposited into a masked pattern of nanopores. However, there is nothing of record to indicate that such a product could be made using the present process, and if so, how such a product would be materially different from the product claimed in Group II.

Since the Office has not provided sufficient reasons to reach a conclusion of patentable distinctness between the claims of the restricted groups, Applicants assert that the requirement is improper and should be withdrawn.

Moreover, MPEP §803 states:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has not met the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn. Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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